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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,984	09/15/1999	ANOOP GUPTA	MS1-304US	8201
22801	7590	05/02/2005	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			QUELER, ADAM M	
			ART UNIT	PAPER NUMBER
			2179	
DATE MAILED: 05/02/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/396,984

Applicant(s)

GUPTA ET AL.

Examiner

Adam M Queler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 35-82 is/are pending in the application.
- 4a) Of the above claim(s)        is/are withdrawn from consideration.
- 5) ☐ Claim(s) 63-70 is/are allowed.
- 6) ☐ Claim(s) 35-50, 56-59, 62 and 71-82 is/are rejected.
- 7) ☐ Claim(s) 51-55, 59 and 61 is/are objected to.
- 8) ☐ Claim(s)        are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on        is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No.       .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. This action is responsive to communications: RCE and Amendment filed 02/14/2005.
2. Claims 35-82 are pending in the case. Claims 35, 50 63, 71, and 80 are independent claims.

#### *Continued Examination Under 37 CFR 1.114*

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/14/2005 has been entered.

#### *Claim Objections*

4. Claim 74 is objected to because of the following informalities: On line 1, "serve" is used instead of "server." Appropriate correction is required.

#### *Claim Rejections - 35 USC § 112*

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 60, 76-78, and 80-82 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The term "substantially" in claim 60 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably

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apprised of the scope of the invention. It is further unclear whether or not “substantially” is intended to mean approximately close in time, or referring to a margin of error introduced in the time compression taught in the specification.

The meaning of the term “provision” is unclear from the context it is used. For examining purposes only the term will be generally taken to mean, “supply.”

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. **Claims 71-82 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Both claims 71 and 82 do not recite any feature that is necessarily implemented in hardware. Therefore there is no recitation, implicitly or explicitly, of any tangible structure. Therefore the claims are rejected as being directed to not being tangible.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 35-37, 39, 42-50, 56, 71-75 and 80-82 rejected under 35 U.S.C. 102(e) as being anticipated by deVries et al. (USPN 6332144—(priority date 3/11/1998)).**

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**Regarding independent claim(s) 35, 50,** deVries teaches an annotation object corresponding to a media content (Fig. 10, Fig. 7). DeVries teaches an annotation entry (Fig. 10) containing: an identifier (152), a media characteristic (158, 160), and a version identifier (132) corresponding to a plurality of versions of the multimedia content (Fig. 9). DeVries teaches storing the entry (col. 16, ll. 55-60).

**Regarding dependent claim(s) 36,** deVries teaches a second annotation corresponding the same content, in the same format as the first (Fig. 10).

**Regarding dependent claim(s) 37,** deVries teaches two annotations corresponding to the same content have the same object identifier (Fig. 10, 132). This defines them as part of the same annotation collection.

**Regarding dependent claim(s) 42,** deVries teaches a set identifier (Fig. 10, 156).

**Regarding dependent claim(s) 43,** deVries teaches temporal position information (Fig. 10, 158, 160).

**Regarding dependent claim(s) 44,** deVries teaches a segment identifier (Fig. 10, 158, 160).

**Regarding dependent claim(s) 45,** deVries teaches an event identifier (Fig. 10, 158, 160).

**Regarding dependent claim(s) 46,** deVries teaches begin and end time (Fig. 10, 158, 160).

**Regarding dependent claim(s) 47,** deVries teaches the content is a streaming multimedia presentation (col. 2, ll. 19-20).

**Regarding dependent claim(s) 48,** deVries teaches the multimedia content comprises a plurality of media objects that share the same content, merely a different format, and therefore inherently, a common timeline (col. 15, ll. 56-64).

**Regarding dependent claim(s) 49,** deVries teaches the objects comprise video (Fig. 9)

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**Regarding dependent claim(s) 56**, deVries teaches versions represented by a URL, (Fig. 9, 146).

**Regarding independent claim(s) 71**, deVries teaches receiving, creating, and maintaining a plurality of annotation object corresponding to a media content (Fig. 10, Fig. 7). DeVries teaches an annotation entry (Fig. 10) containing: an identifier (152), a media characteristic (158, 160), and a version identifier (132) corresponding to a plurality of versions of the multimedia content (Fig. 9). DeVries teaches storing the entry (col. 16, ll. 55-60).

**Regarding dependent claim(s) 72**, deVries teaches an authoring the new annotation object (col. 14, ll. 1-10).

**Regarding dependent claim(s) 73**, deVries teaches that a standard relational database is used (col. 14, ll. 53-54). A standard relational database inherently is configured to delete an object and entries.

**Regarding dependent claim(s) 74**, deVries teaches that a standard relational database is used (col. 14, ll. 53-54). A standard relational database inherently is configured to edit an object and entries.

**Regarding dependent claim(s) 75**, deVries teaches that a standard relational database is used (col. 14, ll. 53-54). A standard relational database inherently is configured to edit an object and entries.

**Regarding independent claim(s) 80**, deVries teaches maintaining a plurality of annotation object corresponding to a media content (Fig. 10, Fig. 7). DeVries teaches an annotation entry (Fig. 10) containing: an identifier (152), a media characteristic (158, 160), and a version

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identifier (132) corresponding to a plurality of versions of the multimedia content (Fig. 9).

DeVries teaches supplying a specific version of a specific multimedia presentation (col. 15, ll. 55-64). DeVries teaches supplying an annotation object synchronized with a media characteristic (col. 16, ll. 42-54).

**Regarding dependent claim(s) 81**, DeVries teaches supplying a requested version of the presentation (col. 8, ll. 20-30).

**Regarding dependent claim(s) 82**, DeVries teaches requesting and displaying the version of the content (col. 7, ll. 33-40).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 38-41, 57-59, 62 and 76-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over deVries.**

**Regarding dependent claim(s) 38, 40, 57**, deVries does not explicitly disclose creation of multiple entries, such as those described in claim 1, corresponding to different media contents. It would have been obvious to one of ordinary skill in the art at the time of the invention to create an additional entry corresponding to a second content, as the object identifier (132) exists explicitly to permit separate annotations to correspond to separate media contents (col. 17, ll. 1-22).

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**Regarding dependent claim(s) 39, 41,** deVries teaches two annotations corresponding to the different content have the different object identifier (col. 17, ll. 1-22). This defines them as part of the different annotation collection.

**Regarding dependent claim(s) 58,** deVries does not explicitly disclose creation of multiple entries, such as those described in claim 1, corresponding to different media contents. It would have been obvious to one of ordinary skill in the art at the time of the invention to create an additional entry corresponding to a second content, as the object identifier (132) exists explicitly to permit separate annotations to correspond to separate media contents (col. 17, ll. 1-22).

DeVries teaches a version identifier of a second multimedia content (Fig. 9, 132). DeVries teaches identifying and retrieving the plurality of annotation objects associated with the media content (col. 19, ll. 65-67). DeVries does not explicitly teach rendering the annotation. It would have been obvious to one of ordinary skill in the art at the time of the invention to render the annotations concurrently corresponding to the media characteristic. It would be obvious because deVries associates annotations with a start and end time, indicating a specific interval in which it would be desirable to play the annotation (col. 16, ll. 42-54).

**Regarding dependent claim(s) 62,** deVries suggests rendering the annotations concurrently corresponding to the media characteristic as described above. DeVries teaches that media characteristic is a start and end time (col. 16, ll. 42-54). It would have been obvious to one of ordinary skill in the art at the time of the invention to display the annotations as a function of start time, because the start time has an inherent logical meaning that would suggest playing the annotation at it's logically correct time.



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**Regarding dependent claim(s) 76**, deVries teaches supplying a specific version of a specific multimedia presentation (col. 15, ll. 55-64). DeVries teaches supplying an annotation object synchronized with a media characteristic (col. 16, ll. 42-54).

**Regarding dependent claim(s) 77**, deVries teaches supplying a requested version of the presentation (col. 8, ll. 20-30).

**Regarding dependent claim(s) 78**, deVries teaches requesting and displaying the version of the content (col. 7, ll. 33-40).

**Regarding dependent claim(s) 59 and 79**, deVries teaches a set identifier (Fig. 10, 156).

***Allowable Subject Matter***

13. Claims 51-55, 61, 63-70 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Claim 60 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

15. The following is a statement of reasons for the indication of allowable subject matter: deVries specifically teaches that annotations are synchronized to the same clock of the representations of media contents. Therefore no suggestion exists to account for any sort of time compression that would necessitate having a base time version and a target time version. DeVries is the best available art that teaches multiple versions of media corresponding to a set of annotations. However, it does not specifically teach the playing the annotations, though does

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fairly suggest it, as recited in the rejections above. However, there is no suggestion to render the annotations in any order other than the time to which they logically correspond.

### *Conclusion*


16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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